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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,541	01/05/2001	Anthony R. Rothschild	733755-6	5271
23879	7590	07/12/2006	EXAMINER	
BRIAN M BERLINER, ESQ O'MELVENY & MYERS, LLP 400 SOUTH HOPE STREET LOS ANGELES, CA 90071-2899				CARLSON, JEFFREY D
		ART UNIT		PAPER NUMBER
		3622		

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/755,541	ROTHSCHILD, ANTHONY R.
	Examiner	Art Unit
	Jeffrey D. Carlson	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 June 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-61 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 20060626.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Upon reassessment of applicant's 131 affidavit filed 12/27/04, Examiner has judged the affidavit to be ineffective in overcoming the previous art rejection which relied upon Stanbach, Jr. et al (US6449657), KR99073076A and Camut et al (US6684257). Therefore, the rejection is being repeated herein.

The declaration filed on 12/27/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the rejections relying on the Stanbach, Jr. et al (US6449657), KR99073076A and Camut et al (US6684257) references.

The evidence submitted is insufficient to establish conception of the invention prior to the effective date of the references. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

- The declaration fails to present facts that the advertisement is adapted to direct the (server's) advertising application to send the additional communication data to the interacting message recipient. The declaration includes facts that make mention of advertising that contains URLs or links, yet these are assumed to be simple hyperlinks that direct the clicking

recipient to the additional communication data directly without assistance from the server.

- The declaration fails to present facts regarding the determination of a particular device's required format and the subsequent formatting of the additional communication data consistent with the formatting requirements.
- The declaration fails to present facts regarding most, if not all of the subject matter of the dependant claims.
- Applicant presents "Cyber Lab's Detailed Proposal" (Appendix D) as providing facts showing conception prior to August 6, 1999, yet the document is merely dated "August 1999," therefore leaving questions as to whether it predates the Stanbach reference (8/6/1999).
- Applicant is reminded that: The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of **37 CFR 1.131(b)**. *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re*

*Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

"In determining the sufficiency of a **37 CFR 1.131** affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958)." MPEP 715.07(a).

"[I]t is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence." MPEP 715.07(a).

While the Examiner is not ruling at this time on the sufficiency of the showing of diligence, Examiner points out that paragraph 12 of the declaration appears to provide allegations rather than facts.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

The disclosure contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Applicant should deleted the URLs/email links on page 10 line 26, page 13 line 17, page 16 line 4.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-11 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- Claim 10, it is further not clear how a “populated communication page” (a completed web-mail as per figure 4 and pages 16-17) is used to provide the described effect of extraction of an advertisement from the additional communication data (i.e. the data that is presented after a receiving user clicks the advertisement). The claim appears circular.
- Claim 25 – Examiner has previously rejection the claim under 112 ¶1 for lacking enablement for the web host formatting the personal communication (i.e. original email) pursuant to the recipient device’s formatting requirements. Applicant has responded (12/27/04) by referring to figure 7 and apparently page 18 line 18 to page 19 line 4 and page 20 line 24 to page 21 line 17. Yet figure 7 and pages 20-21 of the specification describe the interaction with an already-delivered personal communication, not how the personal communication and its included advertisement are originally formatted

specific to the receiver's device. Page 18 refers to a reformatting of the personal communication (original email) for the receiver's device, yet this is accomplished by the *receiver's email server*, not the web host that provides the advertising application in base claim 1. Figure 2 of the disclosure shows the receiver's email server as separate from the web host providing the advertising application.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al (US6449657) in view of KR99073076A (application published 10-5-1999; WO 00/58882 is part of the patent family and is being used as a translation) and Camut et al (US6684257).

Regarding claims 1, 18, 19, 25, 31, 42, 49, Stanbach, Jr. et al teaches an email server which selects advertisements and inserts them (attaches or embeds) into personal communication messages composed by a sender [col 9]. A demographic profile provided by the sender determines the selected/inserted ad; this can be said to be "selection" by the sender as the sender is responsible for the profile-based selection. However, KR99073076A also teaches an email system where ads are inserted into

emails. KR99073076A teaches that the sender can select the ad to be included from a selection of plural ads [pg 3 lines 4-8, pg 6 lines 11-13]. It would have been obvious to one of ordinary skill at the time of the invention to have enabled the sending user to select the ad to be included as taught by KR99073076A, so that the sender can control and define the highly targeted ads. Stanbach, Jr. et al teaches that the ads may include URLs or HTML inserted into the message body and may link the recipient to more information upon activation/interaction [14:43-47]. It would have been obvious to one of ordinary skill at the time of the invention to have stored and provided the additional requested data on the email host as a matter of design choice so that the host can provide the requesting recipient with the additional data. Camut et al teaches that it is well known for requesting Internet browser clients to have special data format needs. Camut et al teaches that it is well known to identify the requesting browser/client/hardware, transcode the requested data into a preferable format and deliver it to the requesting client for rendering [2:28-43, 3:1-30]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such transcoding services with the ad email service so that PDA, cell phone, etc recipients of the email ads can request and properly render the additional information.

Regarding claims 5, 6, 52, KR99073076A teaches that the email address of the server may be used to redirect the mail. Further, Stanbach, Jr. et al teaches deletion of the senders email by the system [pg 11:4-16].

Regarding claims 7, 8, 33, 34, 50, 51, it would have been obvious to one of ordinary skill at the time of the invention to have presented the sender with the ad

categories in order to organize the possible selections. KR99073076A teaches that the user's selections can be stored by the system [10:1-3]. Further, Official Notice is taken that it is known to identify selections made by a user as "recently used" or "favorites." it would have been obvious to one of ordinary skill at the time of the invention to have defined a user-pallet of ads for selection, using the user's previous selections so that a "favorites" list is created and can be used for future selections without requiring the user to review all possible selections.

As best understood regarding claims 9-12, 16, 17, 21, 48, 57-59, it would have been obvious to one of ordinary skill at the time of the invention to have received additional data directly from any party including the email service, sender, advertiser or other 3<sup>rd</sup> party regarding the additional communication data. The system inherently extracts its data from storage; any of the provided data can be taken to be "advertisement" data or additional communication data. The system as proposed inherently generates a personal communications (email).

Regarding claims 13-15, 35-37, 53, 61, KR99073076A teaches compensation for senders and recipients upon sending and viewing the additional ad information. It would have been obvious to one of ordinary skill at the time of the invention to have compensated any of the parties for any of the steps of sending ads, viewing ads, requesting more ad info and making purchases, so as to encourage maximum advertising and commerce.

Regarding claims 20-22, a "staff" member tasked with programming, running, maintaining, backing up, troubleshooting, (etc...) the system of Stanbach, Jr. et al is

taken to inherently have access to the stored data. Stanbach, Jr. et al teaches that served ads can be tracked and stored so that advertisers can receive feedback regarding the advertising [14:60-62]. Stanbach, Jr. et al teaches that the ad insertions are tracked using ad identifiers [14:50-52, 13:5-7]. It would have been obvious to one of ordinary skill at the time of the invention to have granted 3<sup>rd</sup> party advertisers secure access to the system so that they can provide advertising information and extract advertising usage data/reports from the system in a manner as is well known.

Regarding claims 26-30, 43, 44, 54, Camut et al teaches mobile clients (PDAs, Internet capable phones, etc) that can receive Internet web page data. It would have been obvious to one of ordinary skill at the time of the invention for both senders and receivers to be using such devices and to access the email application server for convenience. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded any necessary plug-in or client software from the application system as required to the “pervasive” wireless mobile devices of Camut et al, so that mobile users can create, submit, send and receive emails using the system wirelessly. Regarding claim 30, connecting the mobile client to the email system is taken to inherently provide “compiled” identifying the client and the selected ad when the user accesses the system to choose an ad for delivery.

Regarding claim 32, Stanbach, Jr. et al teaches that the ads can be selected randomly [13:14-16].

Regarding claims 38-40, KR99073076A provides a means for preventing fraud [11:18-24] whereby compensation to the sender is limited. It would have been obvious

to one of ordinary skill at the time of the invention to have limited the sender's compensation in any way including by limiting the number of times (including a single time) a recipient can be used for delivering an ad, in order to prevent spamming and revenue generation with sending numerous emails to recipients.

5. Claims 2-4, 41, 45-47, 55, 56, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al in view of KR99073076A and Camut et al further in view of Bayeh et al (US6012098). Bayeh et al teaches that XML and XSL style sheets can be used to provide requested information as a device and data neutral format, separating the content of the data from its possible display formatting. It would have been obvious to one of ordinary skill at the time of the invention to have used XML with the email ad system so that requested additional data by the recipients can be retrieved and formatted for a variety of platforms and devices. The steps of retrieving and formatting the requested information is inherently separate from the output/delivery stage (which uses TCP/IP).

6. Claims 23, 24, 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanbach, Jr. et al, KR99073076A and Camut et al in view of Rakavy et al (US6317789). Stanbach, Jr. et al teaches that he ads may be in various formats, including multimedia [20:59-61]. Rakavy et al teaches an online ad system whereby multimedia ad files are sent to the client along with the required players to render the ads [12:30-48]. It would have been obvious to one of ordinary skill at the time of the

invention to have sent the ad data (first portion) and the required plug-ins/players/client viewers as needed (second portion).

### ***Response to Arguments***

7. Applicant argues that the presence of links in the specification are needed in order to comply with 112P1. Examiner disagrees. The format of URLs and mail links are notoriously well known and the specific examples are not needed to convey to one of ordinary skill how to make and use the invention. Applicant can leave the disclosure regarding the need for such links, yet should delete the exemplary syntax.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patents 6205432 (Gabbard et al), 6449657 (Stanbach, Jr. et al) and 6523008 (Avrunin et al) each teach a (sending) server that selects advertising to be included with personal communication messages.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

This application is in condition for allowance except for the following formal matters: links in the specification, 112P2 rejection of claims 9-11 regarding the user providing the additional communication data.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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